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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* HIDEAKI MURAKAMI

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Appeal 2009-013493  
Application 10/698,481  
Technology Center 3600

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Before: JENNIFER D. BAHR, FRED A. SILVERBERG, and WILLIAM V. SAINDON, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Hideaki Murakami (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1, 5, 6, 8-10, and 13 under 35 U.S.C. § 102(b) as being anticipated by Umezawa (US 6,740,606 B2, iss. May 25, 2004) and of claims 11, 12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Umezawa and Hsu (US 6,269,008 B1, iss. Jul. 31, 2001). The Examiner has withdrawn claims 2-4 and 7 from consideration. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

The claims are directed to a cushioning body capable of eliminating the effect of vibrations and radiating heat, as well as blocking electromagnetic radiation, for use around an electromagnetic wave generating unit, such as a hard disk drive ("HDD") device. Spec. 1:8-11; 2:21-25. Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A cushioning body comprising:
  - a heat radiating elastic member arranged around an electromagnetic wave generating unit to provide cushioning for protection from physical shock and radiate heat generated by the electromagnetic wave generating unit; and
    - an electromagnetic wave blocking member arranged in the heat radiating elastic member.

OPINION

Each of Appellant's independent claims 1 and 13 requires a heat radiating structure that provides cushioning for protection from physical shock. In rejecting the claims, the Examiner found that Umezawa's resin layer 2 has the capability to provide such cushioning. Ans. 3, 5. In particular, the Examiner found that the thermoplastic resin sheet 12, comprised of an olefin-type elastomer sheet (Embodiment 4), has such cushioning capability. Ans. 5.

Appellant argues that Umezawa is silent with respect to the resin sheet 12 having any cushioning capability, and that cushioning capability is not an inherent feature of the resin sheet. App. Br. 5-8; Reply Br. 3-6.

Accordingly, an issue raised in this appeal is whether the Examiner has established a prima facie case that Umezawa's thermoplastic resin sheet 12 possesses the capability to provide cushioning for protection from physical shock.

The embodiment of the resin sheet relied upon by the Examiner is an olefin-type elastomer sheet having a thickness of 0.2 mm and containing 40 parts by weight JSR DYNARON (a hydrogenated styrene-butadiene rubber) and 60 parts by weight polypropylene. Umezawa, col. 14, ll. 5-11.

Umezawa does not teach using the sheet for providing cushioning or describe the sheet as having any shock absorption or cushioning capability. Umezawa discloses cutting the laminated sheet to size and fitting it to the window of a portable telephone for use as an electromagnetic wave shielding window. Umezawa, col. 14, ll. 29-32.

The Examiner asserts that “[s]ince rubber is an elastic material, it is old and well known in the art that an elastic material such as rubber is resilient and flexible and are widely used as cushion and shock absorber.”

Ans. 5. The Examiner further points out that the “cushioning for protection from physical shock” recitations in claims 1 and 13 “are relatively broad and no specifics as to the degree or amount of cushioning needed for protection from shock.” *Id.*

Even accepting as accurate the Examiner’s finding that rubbers having elastic and resilient properties are well known and widely used as cushions or shock absorbers, the Examiner has not provided sufficient evidence or technical reasoning to reasonably establish that the particular material disclosed by Umezawa (an olefin-type elastomer sheet containing 40 parts by weight JSR DYNARON (a hydrogenated styrene-butadiene rubber) and 60 parts by weight polypropylene) necessarily would possess the requisite properties to render it capable of providing any identifiable degree of cushioning for protection from physical shock, especially at the thicknesses contemplated by Umezawa for the disclosed use as an electromagnetic wave shielding window for a portable telephone. Furthermore, Umezawa gives no indication that the sheet discussed in Embodiment 4, or any other sheet discussed by Umezawa, would provide any cushioning for protection from physical shock.

While the Examiner may be correct that Appellant’s claims 1 and 13 do not specify any particular degree of cushioning capability, for the reasons discussed above, the Examiner has not met the burden of establishing a *prima facie* case that Umezawa’s resin sheet would provide any identifiable degree of cushioning for protection from physical shock. Thus, we cannot sustain the Examiner’s rejection of claims 1, 5, 6, 8-10, and 13 as being anticipated by Umezawa.

In rejecting claims 11, 12, and 14 as being unpatentable over Umezawa and Hsu, the Examiner does not rely on Hsu for any teaching that

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would overcome the deficiency of the anticipation rejection discussed above.

Accordingly, we also cannot sustain the rejection of claims 11, 12, and 14.

**DECISION**

For the above reasons, the Examiner's decision is reversed.

**REVERSED**

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